

#### REMARKS

This Amendment is in response to the Office Action dated August 30, 1994. By the present Amendment, claim 22 has been cancelled, claim 24 has been amended to respond to the 35 USC 112 rejection, and new claims 29-31 have been added to further define the invention. Based on the cancellation of claim 22, and the amending of claim 24, reconsideration and removal of the 35 USC 112 rejection is respectfully requested.

Reconsideration and removal of the 35 USC 102(e) rejection of the present claims based on Patel is respectfully requested. In all of the present claims, including newly submitted claims 29 and 31, setting of the mode designating signal into a holding circuit is in response to all of the CAS signal, the WE signal and the RAS signal going to a low level. This is not the case in the Patel reference.

More specifically, although Patel does disclose a DRAM with CAS, RAS and WE signals and a latch circuit 47, there is no disclosure specifically teaching or suggesting the claimed feature of setting a mode designating signal into a holding circuit in response to all of the CAS, RAS and WE signals being at a low level. Instead, Patel teaches a signal 48 being set in the latch circuit 47 in response to receiving two column address bits A1 and A2 which are set in the buffers 19 in response to only the CAS signal dropping (e.g., see column 3, lines 32-35). In other words, the Patel system operation differs significantly from the present claimed invention on this important point. Accordingly, it is respectfully

submitted that the present claims clearly define over the teachings of the Patel patent, and reconsideration and removal of the 35 USC 102(e) rejection is respectfully requested.

Finally, with regard to the statement made in the Office Action that claim 22 is a substantial duplicate of claim 18, it is noted that this point should be obviated by virtue of the cancellation of claim 22. As for new claims 29-31, these each contain structure different from claim 18, as well as format differences.

For example, with regard to structural differences, claim 29 defines that the first circuit (corresponding to the element TC in Fig. 1, for example) includes first, second and third input terminals, while the second circuit (corresponding to the element FN in the drawing) includes first and second input terminals. No such terminals are defined in claim 18. Further, claim 29 specifically defines that the first and second input terminals of the second circuit are coupled to an output of the first circuit (as opposed to claim 18 that merely defines generally that the second means is "coupled to the first means").

As for format differences, unlike claim 18, which defines the feature of the invention in a means plus function format, claim 29 sets forth the features of detection and setting of the designating signal in a wherein clause format. With regard to this, it is noted that nothing in either the recent case of In re Donaldson or the Commissioner's Guidelines regarding that decision at all suggest that a claim defining

features of previously defined circuits in a wherein clause is substantially identical to means plus function limitations. Accordingly, between the structural differences and the format difference of claim 29 relative to claim 18, it is respectfully submitted that claim 29 is clearly not substantially identical to claim 18.

With regard to claims 30 and 31, these claims include the same distinctions over claim 18 discussed above for claim 29, plus additional distinctions. Specifically, in place of calling for a first and second circuit, claims 30 and 31 define a detecting circuit and a setting circuit, respectively. Claim 30 goes further in defining a control terminal and a data input terminal in place of the first and second input terminals of the setting circuit. As such, these claims further emphasize structural distinctions over the means plus function language of claim 18. Accordingly, it is respectfully submitted that claims 30 and 31 clearly are not substantially identical to claim 18.

For the reasons set forth above, it is respectfully submitted that the present application is in condition for allowance, and such action is earnestly solicited.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of, either by telephone discussion or by personal interview, he is invited to contact applicants' attorney, Gregory E. Montone, at the number indicated below.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, Deposit Account No. 01-2135 (501.23549CC5), and please credit any excess fees to said deposit account.

Respectfully submitted,

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